

**REMARKS**

Claims 1, 3, 6, 8, 11-16 and 18 have been amended. Claims 1-20 remain pending in the present application.

Claims 11-15 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The rejection is respectfully traversed. Applicant has amended the claims to address the concerns of the Office Action. Claim 11 now recites "[a] medium judgment computer program stored on a computer-readable storage medium." As such, claims 11-15 are now believed to be in full compliance with § 101. Thus, Applicant respectfully requests that the rejection be reconsidered and withdrawn.

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tosaki in view of Oshimi. The rejection is respectfully traversed.

Claim 1 recites a "medium judgment method which determines authorization of a rewritable storage medium having a read-only area and a rewritable area for use in an optical disk drive" comprising the steps of "permitting running of a starting process of the optical disk drive with the medium when the authorization of the medium is determined as being correct; and inhibiting running of the starting process of the optical disk drive with the medium when the authorization of the medium is determined as being incorrect." Claim 1 further recites that "the method is . . . used to read the rewritable storage medium in a read-only optical disk drive."

Tosaki, by contrast, refers to only a read-only optical disk, as acknowledged by the Office Action, that has a main information area in which data information is recorded in a track having a wobble, and first and second control data areas, each of which is located at an inner periphery position in comparison with the main information area. In particular, using the second control data area, the Tosaki read-

only optical disk can be identified without spoiling the physical format information, the disk production information or the like; in addition, illegal use of the recording medium can be effectively prevented. Oshimi is cited simply as an example of a hybrid disk, with read-only and rewritable sections, as the recording medium to be judged.

The claimed invention, on the other hand, relates to system and method for determining the authorization of a rewritable optical disk with the same reliability as in a rewriteable optical disk drive when the rewriteable optical disk is inserted in a read-only optical disk drive. This is an important feature of the invention. According to the typical illegal copy prevention methods at the time of invention, it was necessary to use an optical disk drive that complied with the illegal copy prevention method when reproducing the contents of software from the disk, which is undesirable. The claimed invention overcomes such a problem.

The Office Action suggests that one of ordinary skill at the time of invention would have been motivated to combine the teachings of Tosaki with those of Oshimi because they both refer to methods for judging whether the information on a disk is to be prohibited from being reproduced. (Office Action at 4). Applicant submits, however, that read-only disk drives were not capable of reading out the specific information (absolute time in pre-groove) from the disk when a rewritable optical disk containing the recorded specific information was inserted into the read-only disk drives. Thus, it would not have been obvious to one of ordinary skill in the art to combine the cited references to achieve the claimed invention. Applicant respectfully submits that there is no such motivation provided by the references themselves and the Office Action lacks an explanation to the contrary.

Moreover, it is improper to combine the references in the manner suggested by the Office Action. Obviousness can only be established by combining or modifying

the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the references themselves. In re Fine, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988). There is no suggestion or motivation in any of the references for combining them to arrive at the claimed invention. In other words, there is no motivation to achieve a medium judgment method "that [is] used to read [a] rewritable storage medium in a read-only optical disk drive." The Office Action is using impermissible hindsight by using the claims of the present invention as a road map to improperly combine the references. See Ex parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. App. 1985); M.P.E.P. §2144. This is another reason why the rejection should be withdrawn.

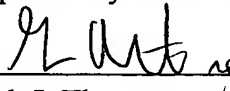
Applicant respectfully submits that Tosaki and Oshimi, even when considered alone or in combination, fail to disclose or suggest all limitations of the claimed invention and also fail to provide a motivation for one of ordinary skill in the art to combine the cited references to achieve the claimed invention. Therefore, the cited combination does not render obvious the limitations of claims 1, 3, 6, 8, 11-16 and 18 and thus, these claims are allowable over the cited combination. Claims 2, 4, 5, 7, 9, 10, 17, 19 and 20 depend from claims 1, 3, 6, 8, 11-16 and 18 and are allowable along with claims 1, 3, 6, 8, 11-16 and 18.

Accordingly, Applicant respectfully requests that the § 103(a) rejection be withdrawn and claims 1-20 be allowed.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

By  reg # 41,198

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